

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Upon entry of the present amendment, claims 18-23, 32, 34, 35 and 37-44 are pending. Claims 18, 20, 32, 40, 41 and 42 are amended. Support for probes that are single-stranded over their full length before hybridization is found, for example, on page 1, lines 27-34; on page 3, lines 5-10 and throughout the specification. Support for reciting that the FRET acceptor entity and the FRET donor entity of the FRET pair are on different oligonucleotides is found, for example, on page 3, lines 5-10 and throughout the specification.

No new matter is added by the present amendments and the Examiner is respectfully requested to enter them.

### **Allowable Claims**

The Examiner is thanked for indicating that claims 35, 37 and 44 are allowable.

### **Telephone Interview**

The Examiner is thanked for the courteous telephone interview on May 16, 2007. The issues discussed are set forth in the pending Office Action and in the present response. Claim language acceptable to the Examiner was also discussed. Applicants have amended the claims in accordance with what was understood to be found allowable by the Examiner.

### **Rejection under 35 U.S.C. § 112, first paragraph, written description requirement**

The Examiner has rejected claims 18-23, 40-41 and 43 under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. In particular, the Examiner objects to language setting forth that the oligonucleotide carries a FRET acceptor entity but not a FRET donor entity. Applicants do not agree with the Examiner's reasoning. However, in the interest of furthering prosecution, Applicants have amended the claims to delete the language found objectionable to the Examiner. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

**Rejection under 35 U.S.C. § 102(e)**

The Examiner has rejected claims 18, 19, 22 and 43 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,866,366 (“Bao”). The Examiner states that claim 18 does not require that the first single-stranded oligonucleotide and the second single stranded oligonucleotide are single stranded before hybridization. *See*, pages 4 and 6 of the present Office Action. Applicants do not agree with the Examiner’s position. However, in the interest of furthering prosecution, Applicants have amended claim 18 to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. Because Bao does not teach or suggest FRET hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization, Bao does not anticipate the present invention. Accordingly, the Examiner is respectfully requested to withdraw the present rejection.

**Rejections under 35 U.S.C. § 103(a)**

**Bao in view of Nazarenko**

The Examiner has rejected claim 23 under 35 U.S.C. § 103(a) as allegedly rendered obvious over Bao in view of U.S. Patent No. 5,866,336 (“Nazarenko”). The Examiner again alleges that claim 18 (from which claim 23 depends) does not require that the first single-stranded oligonucleotide and the second single stranded oligonucleotide are single stranded before hybridization. *See*, page 8 of the present Office Action. Applicants do not agree with the Examiner’s position. However, in the interest of furthering prosecution, Applicants have amended claim 18 to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. Bao does not teach or suggest FRET hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization. Nazarenko does not supply the elements missing from Bao for reasons already made of record. Therefore, the combined disclosures of Bao and Nazarenko do not teach or suggest all of the elements of the claims. Accordingly, the Examiner is respectfully requested to withdraw the present rejection.

Bao in view of Wittwer

The Examiner has rejected claims 32, 34 and 38 under 35 U.S.C. § 103(a) as allegedly rendered obvious over Bao in view of U.S. Patent No. 6,635,427 ("Wittwer"). The Examiner again alleges that claim 18 does not require that the first single-stranded oligonucleotide and the second single stranded oligonucleotide are single stranded before hybridization. *See*, pages 11 and 13 of the present Office Action. Applicants do not agree with the Examiner's position. However, in the interest of furthering prosecution, Applicants have amended claim 32 (from which claims 34 and 38 depend) to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. Bao does not teach or suggest FRET hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization. Wittwer does not supply the elements missing from Bao for reasons already made of record. Therefore, the combined disclosures of Bao and Wittwer do not teach or suggest all of the elements of the claims.

The Examiner also alleges that claims 19 and 34 are identical and claims 22 and 38 are identical. Applicants respectfully point out that claims 19 and 34 are not identical. Whereas claim 19 recites a "second entity" and depends from claim 18, claim 34 recites a "nitroindole moiety" and depends from claim 32. Claims 22 and 38 are also not identical. Whereas claim 22 depends from claim 18 or 20, claim 38 depends from claim 32.

In view of the foregoing, the Examiner is respectfully requested to withdraw the present rejection.

Bao in view of Wittwer, further in view of Nazarenko

The Examiner has rejected claim 39 under 35 U.S.C. § 103(a) as allegedly rendered obvious over Bao in view of Wittwer and further in view of Nazarenko. Applicants do not agree with the Examiner's position. However, in the interest of furthering prosecution, Applicants have amended claim 32 to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. The Examiner concedes that Bao, the primary reference in each of the alleged obviousness rejections, does not teach or suggest FRET

hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization. *See*, pages 4, 6, 8, 11 and 13 of the present Office Action. Wittwer and Nazarenko do not supply the elements missing from Bao. Therefore, the combined disclosures of Bao, Wittwer and Nazarenko do not teach or suggest all of the elements of the claims. Accordingly, the Examiner is respectfully requested to withdraw the present rejection.

Bao in view of Wittwer, further in view of Segev

The Examiner has rejected claim 42 under 35 U.S.C. § 103(a) as allegedly rendered obvious over Bao in view of Wittwer and further in view of U.S. Patent No. 5,437,977 ("Segev"). The Examiner again alleges that claim 18 does not require that the first single-stranded oligonucleotide and the second single stranded oligonucleotide are single stranded before hybridization. *See*, page 16 of the present Office Action. Applicants do not agree with the Examiner's position. However, in the interest of furthering prosecution, Applicants have amended claim 42 to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. Bao does not teach or suggest FRET hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization. Wittwer and Segev do not supply the elements missing from Bao for reasons already made of record. Therefore, the combined disclosures of Bao, Wittwer and Segev do not teach or suggest all of the elements of the claims. Accordingly, the Examiner is respectfully requested to withdraw the present rejection.

Bao in view of Segev

The Examiner has rejected claim 40 under 35 U.S.C. § 103(a) as allegedly rendered obvious over Bao in view of Segev. The Examiner again alleges that claim 18 does not require that the first single-stranded oligonucleotide and the second single stranded oligonucleotide are single stranded before hybridization. *See*, page 18 of the present Office Action. Applicants do not agree with the Examiner's position. However, in the interest of furthering prosecution, Applicants have amended claim 40 to set forth that the first and second oligonucleotides are single-stranded over their full length before hybridization. Bao does not

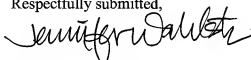
teach or suggest FRET hybridization probes where the first and second oligonucleotides are single-stranded over their full length before hybridization. Segev does not supply the elements missing from Bao. Therefore, the combined disclosures of Bao and Segev do not teach or suggest all of the elements of the claims. Accordingly, the Examiner is respectfully requested to withdraw the present rejection.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Jennifer L. Wahlsten  
Reg. No. 46,226

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
Attachments  
JLW:jlw  
61054519 v1